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In re Application of LIU et al :
U.S. Application No.: 10/511,718 :
PCT Application No.: PCT/CA03/00566 :
Int. Filing Date: 16 April 2003 : COMMUNICATION
Priority Date Claimed: 16 April 2002 :
Attorney Docket No.: 9896-000053/NP :
For: TUBERCULOSIS VACCINES INCLUDING :
RECOMBINANT BCG STRAINS... :
:

This is in response to the declaration filed 02 May 2005.

BACKGROUND

On 16 April 2003, applicant filed international application PCT/CA03/00566, which claimed priority of an earlier United States application filed 16 April 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 30 October 2003. The thirty-month period for paying the basic national fee in the United States expired on 18 October 2004 (16 October 2004 was a Saturday).

On 18 October 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 March 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 May 2005, applicant filed an executed declaration.

DISCUSSION

The declaration filed 02 May 2005 is improper. MPEP 605.04(a), Section II, states in relevant part:

The oath or declaration required by 35 U.S.C. 115 must be signed by all of the actual inventors, except under limited circumstances. 35 U.S.C. 116 provides that joint inventors can sign on behalf of an inventor who cannot be reached or refuses to join. See MPEP § 409.03(a). 35 U.S.C. 117 provides that the legal representative of a deceased or incapacitated inventor can sign on behalf of the inventor. If a legal representative executes an oath or declaration on behalf of a deceased inventor, the legal representative must state that the person is a legal representative and provide the citizenship, residence, and mailing address of the legal representative. See 37 CFR 1.64, MPEP § 409.01 and § 409.02. 35 U.S.C. 118 provides that a party with proprietary interest in the invention claimed in an application can sign on behalf of the inventor, if the inventor cannot be reached or refuses to join in the filing of the application. See MPEP § 409.03(b) and § 409.03(f). The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so. Opinion of Hon. Edward Bates, 10 Op. Atty. Gen. 137 (1861). See also Staeger v. Commissioner of Patents and Trademarks, 189 USPQ 272 (D.D.C. 1976) and In re Striker, 182 USPQ 507 (PTO Solicitor 1973) (In each case, an oath or declaration signed by the attorney on behalf of the inventor was defective because the attorney did not have a proprietary interest in the invention.).

In the present case, applicant has not made a sufficient showing that inventors Jeffrey Chen and David Alexander cannot be reached, refuse to join, or are deceased/incapacitated.

CONCLUSION

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Defective Response (Form PCT/DO/EO/916), which should indicate that the declaration filed 02 May 2005 is improper.



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